

REMARKS

By the foregoing amendments claims 14-44 have been cancelled and new claims 45-60 have been added. Thus, claims 45-60 are in the application. A request for continued examination under 37 C.F.R. §1.114 and the fee set forth in §1.17(e) are filed herewith.

Claims 19, 21, 33, 35, 42, 44, 18, 20, 32, 34 and 43 were rejected in the outstanding Office Action under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement with respect to support for the limitations "curved positioning notch does not cause loss of wafer structurable area for electronic components" and "curved positioning notch does not divide the wafer into several sections" as recited in the claims, see paragraph 1 on page 2 of the Office Action. While these limitations are supported by the application disclosure, including the application drawings which show no loss of wafer structurable area for electronic components and no divisions of the wafer into several sections as a result of providing the wafer with the curved positioning notch of the invention, the propriety of this rejection has been rendered moot by the cancellation of the rejected claims and the fact that new claims 45-60 do not contain these specific limitations. The new claims are believed proper under 35 U.S.C. §112, first paragraph.

Applicants gratefully acknowledge the personal interview granted by Primary Examiner Long Pham to their undersigned attorney on April 14, 2004. During the interview specific portions of the specification of applicants U.S. Patent No. 5,230,747, for which the present application seeks reissue, were referred to by the undersigned in connection with new claims 45-60 to show written description support for the claims under 35 U.S.C. §112, first

paragraph. These included, for limitations appearing in the new claims which are changed/not formed in the original patent claims:

Claim 45

...curved positioning notch...see patent column 7, lines 37-40
...wherein an outer peripheral part of said wafer is chamfered in a thickness direction by mechanical chamfering...and
...connecting portions chamfered in a plane parallel to said main surface by mechanical chamfering...see patent Fig. 3, col. 5, lines 63-65; col. 7, lines 49-52; col. 1, lines 45-50; col. 8, lines 16-18.

Claim 46

...curved positioning notch...see patent col. 7, lines 37-40
...wherein an outer peripheral part of said wafer is chamfered in a thickness direction by grindstone...see above noted claim 45 for patent citations and see patent col. 7, lines 58-64.

Claim 47

...curved position notch...see patent col. 7, lines 37-40
...positioning said wafer by rotating said wafer...see patent Fig. 4 and col. 3, lines 33-50.

Claim 48

...by using photoelectric elements...see patent col. 3, lines 46-50.

Claim 51

...by optical means...see patent col. 3, lines 45-50.

Claim 54

...wherein positioning said wafer by rotating said wafer is to be performed...see patent Fig. 4 and col. 3, lines 33-50.

Applicants respectfully submitted that there is proper written description support, 35 U.S.C. §112, first paragraph, for new claims 45-60 in the specification.

The form of the amendment filed April 30, 2002 was objected to in the Office Action as being improper because of the lack of underlining of new subject matters of newly added claims, 37 C.F.R. §1.173(b)(2). Responsive to this objection, it is noted that newly presented claims 45-60 are underlined in accordance with the requirements of 37 C.F.R. §1.173(b)(2).

Claims 14-44 were rejected in the Office Action under 35 U.S.C. §251 as being improperly broadened in that limitations in the claims concerning a photoresist film located on the surface of the wafer and patterns located on the surface of the wafer recited in the claims, are subject matters not covered by the original patent claims 1-3. This rejection has been rendered moot by the cancellation of claims 14-44 and the fact that new claims 45-60 do not include these limitations but contain all of the limitations of a claim of the original patent as discussed during the personal interview and as seen from a side by side comparison of the claims. Accordingly, new claims 45-60 are not broader under 35 U.S.C. §251 than the original patent claims. See the discussion in the remarks on pages 12-15 of the Amendment filed April 30, 2002 concerning the test for broadening under 35 U.S.C. §251.

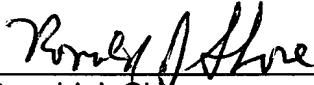
The M.P.E.P. section 2173.05(p) was also cited during the interview in support of the propriety under 35 U.S.C. §112, second paragraph, of the use of intended use language in a claim to an article of manufacture. This notation was made in connection with claim 54, directed to a wafer, which

includes the limitation "wherein positioning said wafer by rotating said wafer is to be performed."

In view of the above amendments and remarks, reconsideration and allowance of new claims 45-60 is requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 501.20289RC6) and please credit any excess fees to such deposit account.

Respectfully submitted,



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Attachments